

REMARKS

In response to the Advisory Action mailed on July 10, 2008, and the Final Office Action mailed February 22, 2008, Applicants request reconsideration and withdrawal of the rejection based on the foregoing. Claims 3-6, 10-27 are currently pending and stand rejected. Claims 3, 10, and 24 are amended to clarify the preexisting scope of those claims. New claims 28-30 have been added. No new matter has been added by these amendments. Applicants incorporate the remarks of the previous responses herein. For at least those reasons and the reason discussed below, the claims are in condition for allowance.

112 Second Paragraph Rejections

Applicants repeat and incorporates the remarks from the previous response. Moreover, the Advisory Action states that the Applicants continue to disregard the Examiner's request to provide a definition from the specification for "the modular personal network is about the same size as a user's personal space."

Applicants do not understand why the Advisory Action ¶ 1(a) is quoting text that is not recited in the claims. The current language in claims 3, 10, 18, and 25 is "the modular personal network is about the size as a user's personal space." It is unclear if the amended claim language has been considered. If so, the prior Office Actions have not communicated that point to the Applicants. Applicants are again left guessing as to the state of the rejection.

Nevertheless, Applicants' responses of March 13, 2007 and June 13, 2007 did provide an explanation of the terms based on the Specification. Applicants reiterate and incorporate those remarks herein. Also, the term "about the [same] size as" was previously rejected as a relative term. However, the Specification describes "about the size of" and provides a standard to measure "about the size as a user's personal space":

- [0014] Personal: The devices are small and designed to be carried or worn by a user. As such, they may be worn at the waist, around the wrist, mounted to an item of clothing, carried in a pocket or purse, or mounted to a piece of the user's personal equipment, etc. The network is preferably unobtrusive and may not even be noticed by other individuals. The entire network is preferably about the same size as the user's "personal space".

- Also from parent application 10/645,713: [0178] FIG. 1A shows a block diagram of illustrative MPN 10A. This MPN includes INCs 110A, 110B, 110C, and 110D. Each INC includes communication device 120, for communicating with other INCs over wireless communication path 140. Communication device 120 may be, for example, a standard radio frequency wireless transceiver with a range appropriate for a *personal network (e.g., between six feet and sixty feet)*. Communication device 120 may also include hardware and software implementing a standard wireless protocol, such as Bluetooth or IEEE 802.15. An antenna may be included. If desired, transmitter and receiver may be separate devices. Not shown in each INC is a power source. (emphasis added)

Moreover, "[t]he fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 USC 112, second paragraph." MPEP 2173; *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). "Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification." MPEP 2173. In the response of November 27, 2007, Applicants explained that one of ordinary skill in the art would understand the meaning of the terms in light of the Specification. Applicants reiterate this argument and incorporate them here. Also, here, a person of ordinary skill in the art understands basic spatial relationships such as "about the size as a user's personal space." Every person has a personal space on which they can wear or mount clothing items and the range of 6-60 feet is readily understandable. Thus this term's meaning is clear.

Also, the actual/specific size of the user's personal space need not be defined to satisfy 35 USC 112. MPEP 2173(A) specifically addresses the term "about":

In determining the range encompassed by the term "about", one must consider the context of the term as it is used in the specification and claims of the application. *Ortho-McNeil Pharm., Inc. v. Caraco Pharm. Labs., Ltd.*, 476 F.3d 1321, 1326, 81 USPQ2d 1427, 1432 (Fed. Cir. 2007). In *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), the court held that a limitation defining the stretch rate of a plastic as "exceeding about 10% per second" is definite because infringement could clearly be assessed through the use of a stopwatch. MPEP 2173.05 (A)

Similar to the case in Garlock, here infringement of the claim can be easily accessed by using (1) any spatial measuring device and (2) the size of common clothing items such as jewelry to determine if an MPN is about the size as a user's personal space. The claim and specification need not provide a specific range in units.

Lastly, as to this point, nothing in the 35 USC 112 nor the MPEP requires an explicit definition of terms to satisfy 35 USC 112. Rather, "[t]he second requirement [of § 112] ... is evaluated in the context of whether the claim is definite - i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art." MPEP § 2171 (emphasis). As explained above and in the prior responses, one of ordinary skill in the art would understand the meaning of the language in question.

Thus, at least for these reasons, Applicants submit that they have adequately responded to the Advisory Action's 112 second paragraph rejection and that the claims satisfy 35 U.S.C. § 112 second paragraph.

112 New Matter Rejections

The Office action rejected claims 16-20 and 23-27 under 35 U.S.C. § 112, concerning alleged new matter in the claimed features. The scope of claims 16-20, 23-27 can be fairly understood from the Specification which includes by reference parent application 10/645,713. The Specification shows that the Applicants had possession of the invention at the time of filing the application. Support within the Specification for the cited claim language include, but are not limited to:

- "automatically continues to operate"
 - From parent application 10/645,713: [0028] A common protocol also allows new INCs to be added more easily. This invention is "modular," in that new INCs can be added at any time. This may change the function of the overall system. As INCs are added, the system's capabilities will grow. As one INC replaces another, the functions of the system change accordingly. The system will continue to function, with reduced capabilities, as INCs are removed. INCs may be built by various manufacturers, and may have different capabilities.
- "automatically configures to adapt to"

- From parent application 10/645,713, [0030] The MPN may be changed at any time, and the functions of the system may change correspondingly. For example, a new INC may be added, and a new function may be enabled by the system. An INC may be removed, and a function of the system may be disabled. The system may automatically detect a change in the MPN, and correspondingly change the functions. Alternatively, a user may enter a changed configuration, for example into a base station, control unit, or personal computer.
- "automatically join the modular personal network when said individual network component enters the user's personal space"
 - From parent application 10/645,713, [0030] The MPN may be changed at any time, and the functions of the system may change correspondingly. For example, a new INC may be added, and a new function may be enabled by the system. An INC may be removed, and a function of the system may be disabled. The system may automatically detect a change in the MPN, and correspondingly change the functions. Alternatively, a user may enter a changed configuration, for example into a base station, control unit, or personal computer.
 - [0014] Personal: The devices are small and designed to be carried or worn by a user. As such, they may be worn at the waist, around the wrist, mounted to an item of clothing, carried in a pocket or purse, or mounted to a piece of the user's personal equipment, etc. The network is preferably unobtrusive and may not even be noticed by other individuals. The entire network is preferably about the same size as the user's "personal space".
 - From parent application 10/645,713: [0029] Our invention is also "personal." This means that the MPN is small in size, roughly encompassing one person's "personal space." INCs may be worn by the user, they may be carried by the user, or they may just be in close proximity, for example mounted on personal equipment.
- "wherein each individual network component stores network identification information for the current modular personal network"

- From parent application 10/645,713: [0038] All of the INCs within a single MPN may be assigned a single unique identifier. This identifier may be downloaded, for example, from a base station or personal computer to each of the INCs. All communications between INCs may be tagged with this unique identifier. This will prevent interference between the two MPNs used by two different people. INCs in each system will only listen to messages tagged with that MPN's own identifier.
- From parent application 10/645,713: [0039] The unique identifier can also be used to deter theft and other misuse of any INC. Each INC can be programmed to not accept a different unique identifier without explicit authorization from the authorized user, for example on a base station or personal computer. The INCs may also be configured so that the unique identifier they use cannot be extracted to program into a different INC.
- "wherein each individual network component store identification of other individual network components in its current modular personal network"
 - From parent application 10/645,713: [0038] and [0039]. See above.
 - [0142] FIG. 5 shows more detail of the functions that may be provided by security-processing circuitry 543. In function 510, a lock value may be stored in secure memory 541 by security processing circuitry 543.
 - [0146] In function 550, a key value from another INC may be checked to see if it matches the lock value stored in secure memory 541. The key value, along with any desired auxiliary data may be provided. Auxiliary data may include, for example, the current date or time, the identifier of the other INC, the identifier of this INC, or any other suitable value(s).

At least for the reasons discussed above, the 35 U.S.C. § 112 new matter rejection of claims 16-20, 23-27 should be withdrawn and these claims should be allowed.

Rejections under 35 U.S.C. § 103

Claims 3-5, 10-12, and 14-27 are rejected under 35 USC § 103(a) as being unpatentable over Kivela et al (US 6,272,359) (hereinafter Kivela) in view of Anderson (US 6,594,370), (hereinafter Anderson). Applicants respectfully traverse this rejection and incorporate the arguments from the previous responses herein.

Moreover, Anderson discloses one or more earpieces and an RPU necklace worn at the neck of the user. Anderson, 1:15-25. The Office Action appears to suggest that it is implicit that at least one of the ear pieces can be removed, and the remaining RPU necklace and/or other ear pieces can still operate to provide the functions of the remaining RPU necklace and/or other ear pieces.

All the features of independent claims 3 and 10 are not described or obvious by Kivela and Anderson, individually or in combination. For example, claim 3 recites, within the context of the claim, "a new network component can be added to the modular personal network at any time to increase the capabilities of a resulting system." The Office Action concedes that this feature is not described in Kivela and relies on Anderson to meet such a deficiency. However, Kivela also does not describe such a feature. Based on Applicant's review, the only discussion of adding a network component is when it states that (1) peripheral and control equipment can communicate with the earpiece(s) and RPU; (2) a microphone *may* be added; and (3) optional wireless link circuitry along with *necessary* printed antennas can be added. However, there is no discussion on the subject of the addition of these devices **at any time** to increase the capabilities of the resulting network. In addition, there is no discussion that an ear piece or RPU can be added **at any time** to increase the capabilities of the network. The Patent Office cannot simply ignore or read out words from the claim language that is explicitly recited. Given the lack of discussion, the prior art does not disclose such a feature. It cannot be assumed that it is. Nor is it inherent, in that the system in Anderson could be implemented in more than one way.

Further by way of example, claim 3 recites, within the context of the claim, "a single network component can be removed resulting in an operating modular personal network that **can perform without the single network component and its corresponding one or more functions**." (emphasis added) The Office Action concedes that this feature is not described in Kivela and relies on Anderson to meet such a deficiency. However, Kivela also does not

describe such a feature. First, in Kivela, an earpiece relies on the beam of power from the RPU. Moreover, there is no description of what happens when an earpiece is removed from a network. In other words, Kivela does not state or describe what happens to a network or the capabilities of components in the network when an earpiece, two earpieces (Applicant cannot even find a description of a two earpiece embodiment), an RPU, a peripheral equipment, control equipment is removed from an existing network. The Patent Office cannot simply ignore or read out words from the claim language that is explicitly recited. Given the lack of discussion, the prior art does not disclose such a feature. It cannot be assumed that it is. Nor is it inherent, in that the system in Anderson could be implemented in more than one way.

To further clarify these features, Applicant has added a whereby clause to claim 3, which makes clear said deficiencies of Kivela and Anderson.

As such the Examiner has not made a *prima facie* case of obviousness of claim 3. Claim 10 is also non-obvious over Kivela and Anderson at least for the same reasons as claim 3. Also, the dependent claims of claims 3 and 10 are in condition for allowance at least because their parent claims are in condition for allowance.

New Claims

New claim 28 finds support in the Specification. See e.g., original claim 3 and parent application 10/645,713 [0028]-[0039], [0039] of the current application. New claim 29 finds support in the Specification. See e.g., discussion of a system of components throughout the Specification. New claim 30 finds support in the Specification. See e.g., discussion of software throughout the Specification and the incorporated parent application. The new claims recite similar, albeit different features as claim 3 and amended claim 10 and therefore should also be in condition for allowance.

Miscellaneous

Certain remarks were omitted from the previously Amendment as a clerical error. There are provided as follows:

A. Obligation of Complete Office Action

"In accordance with the patent statute, 'Whenever, on examination, any claim of a patent is rejected, or any objection . . . made,' notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given." MPEP § 706. "Where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection *fully and clearly* stated. MPEP § 707.07(d) (emphasis added). In addition, MPEP Section §707.07(f), titled "Answer All Material Traversed," explains that it is the Examiner's obligation to answer the substance of Applicant's arguments. Otherwise, Applicant will have no idea whether the remarks were considered and may consider the lack of such a response a waiver accepting the validity of those arguments.

B. Examiner Interview in March 2008 and Admission of Action Not Complete in All Respects

Upon receipt of the present Office Action (Final Action mailed February 22, 2008), the undersigned attorney contacted the Examiner to determine whether Applicant's substantive remarks in the Amendment filed on November 27, 2007 had been considered because the Office Action did not include an answer to the substantive arguments presented. In response to the first call to the Examiner during which the undersigned communicated the question of whether the arguments had been considered, the Examiner stated that he would need to review the file and that we can discuss the next or subsequent day. In the follow up call, the Examiner refused to answer the question of whether the Applicant's remarks were considered and why they were not considered. Rather the Examiner repeatedly responded with the statement, which to my recollection was, "do you want to setup a time to discuss the issues?" In response, given that the question was not being answered, the undersigned stated that he would consider whether to setup an examiner interview. Thereafter, the undersigned contacted the Examiner's supervisor, Examiner Appiah. In a call involving Examiner Appiah, Examiner Karikari, and the undersigned, an explanation with respect to Applicant's arguments was again requested. During this call, Examiner Karikari stated that the reason why he did not respond to Applicant's arguments is that Applicant did not respond to a definition that he had requested in the previous Office Action. This is the first time the undersigned had been informed that this

was reason he did not consider Applicant's arguments. The Examiner's statement admits that the Action is not complete because the Examiner intentionally withheld from considering Applicant's arguments. Note, that this is not the first time that Applicant has been left guessing with respect to the rejections. As explained in a previous Amendment, Examiner Karikari issued a previous rejection relying on a definition which he did not specify in the Office Action and state in the Action to be the actual ground for a rejection but rather stated it to be the case in an Examiner Interview. The only agreement reached which was a request from Examiner Appiah was to put everything on the record. Accordingly, the undersigned has done so. Allowance or a new non-Final Action is requested based on the remarks herein.

Conclusion

In view of the above remarks, the applicants respectfully request withdrawal of the 35 U.S.C. 103(a) rejections. The application is now believed to be in condition for allowance, early notice of which would be appreciated. Should the Examiner not agree or have any questions, then a personal or telephonic interview is respectfully requested to discuss any remaining issues in an effort to expedite the allowance of this application.

Respectfully submitted,

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